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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,926	03/20/2002	Timo Juhani Kangas	1329/OK329USO	2678
7278	7590	03/09/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,926

Applicant(s)

KANGAS, TIMO JUHAN

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 1-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20 March 2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of a certified copy of application 129992084, filed 29 September 1999 in Finland, referred to in the oath or declaration or in an application data sheet.

If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119(a)-(d), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b). If the application being examined is an original application filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(a)(1)(i). If the application being examined has entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and Regulations of the PCT. See 37 CFR 1.55(a)(1)(ii). Any claim for priority under 35 U.S.C. 119(a)-(d) or (f) or 365(a) or (b) not presented within the time period set forth in 37 CFR 1.55(a)(1) is considered to have been waived. If a claim for foreign priority is presented after the time period set forth in 37 CFR 1.55(a)(1), the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. See 37 CFR 1.55(c).

Claim Objections

Claims 1-10 are objected to because of the following informalities:

Claim 1 refers to "characterized in that it comprises..." The Examiner will interpret "...it.." to refer to the whole of the method of claim 1.

Claims 1-10 contain external references in parentheses. Please refer to MPEP 608.01(m) for proper claim construction.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts".

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See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source **human** language (e.g., Russian) into a target **human** language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within

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the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, Claims 1-7 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. For example, the steps and substeps mentioned in claim 1 could be performed manually by a person physically composing, compiling a list and releasing the information to recipients.

The term "network" could also include sending the items through the US Postal network, using a courier service such as UPS to deliver the items through its network of carriers, etc.. Therefore, the claims are directed towards non-statutory subject matter.

To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating a computer network or electronic network into the communicating steps; for example: "(a) composing via an electronic computer a piece of electronic information or service..."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (US 5,794,210).

As per claims 1 and 8, Goldhaber discloses methods for distributing information and services through networks, including the steps of:

- 1.1 composing a piece of information or service to be distributed. See at least references to advertisements, products and services, at least Col. 1, lines 15-61.
- 1.2 compiling a list of intended recipients. See at least references to targeting an audience by demographic profiles, for example, Col. 2, lines 35-49. see also references to explicit target audience, as in the Abstract, explicit delineation of target audience, as in Col. 5, line 25-Col. 6, line 2. see also references to demographic routing, at least Col. 5, lines 17-55.
- 1.3 releasing said piece of information or service so that it becomes accessible to the recipients appearing on said list. See, for example, references to transmitting information over a network to target audience, at least Col. 10, lines 8-38.

The method includes the steps of:

- 1.5 deciding, before releasing said piece of information or service so that it becomes accessible to the recipients appearing on said list, what form of transmission will be exploited to make said piece of information or service accessible to each recipient appearing on said list. See, for example, references to email, at least Col. 13, lines 1-16, Col. 20, lines 56-67. See also references to content delivery, at least Fig. 2 and related text.

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1.6 as a response to an indication of a certain recipient having accessed said piece of information or service, crediting an account associated with said certain recipient.

See at least Fig. 10, reference 60(c), showing crediting to an account.

As per claim 2, Goldhaber discloses that crediting an account associated with a recipient may include a substep of identifying an account representing the rights of said certain recipient to use certain services through said network. See, for example, at least references to crediting a consumer's account, at least Col. 6, line 24-Col.7, line 18.

As per claim 3, Goldhaber discloses that crediting an account associated with a recipient may include a substep of identifying an *account* the identifier of which has been intentionally provided by said certain recipient. See, for example, at least references to credit card or bank accounts or specialized accounts provided by a recipient, Col. 7, lines 47-62.

As per claim 4, Goldhaber discloses that releasing said piece of information or service (advertisement, for example) may comprise a substep of indicating to at least part of the recipients appearing on said list that accessing said piece of information or service will cause a certain **account** associated with said certain recipient to be credited. See, for example, references to icons that indicate to recipients [selected on the basis of demographics, for example] that accessing the advertisement will cause a user's account to be credited, as in Col. 7, lines 47-61.

As per claim 5, Goldhaber discloses that a step of releasing an advertisement may comprise a substep of transmitting said piece of information or service to a number of subscriber terminals. See, for example, references to target audience, as in claims 1,

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4, above. See also references to consumer/subscriber demographic profiles, as in Col. 6, lines 46-67.

As per claim 6, Goldhaber discloses that a step of releasing an advertisement may comprise substep(s) of

storing said piece of information or service to a place which is accessible for subscriber terminals through a network. See, for example, at least Fig. 10, which shows various types of storage devices for storing advertising information that is distributed through network 102.

transmitting to a number of subscriber terminals an indication of said piece of information or service being available at said place. See, for example, at least references to lists of advertisements available to subscriber(s) at subscriber terminals. The indication may be in the form of a thumbnail view that permits a subscriber to select and view particular advertisements, as in Figs. 12, 13 and related text.

As per claims 8-10, Goldhaber discloses various databases and servers:

source of information or services See, for example, references to information services and servers, reference 106.

number of subscriber terminals. See, for example, at least references to consumer computers 104.

means for maintaining accounts associated with certain subscribers. See, for example, at least references to digital cash repository, Fig. 7 and related text.

The consumer terminals 104 may be different from each other and may be contacted via various modes of transmission, including email, web pages, and others,

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according to consumer requirements. See, for example, at least Col. 13, lines 1-16, Col. 20, lines 56-67. See references to content delivery, at least Fig. 2, related text.

Goldhaber discloses, as in Figs. 1 and 7, database server, an account server, service or information server.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (US 5,794,210).

As per claim 7, Goldhaber does not specifically disclose that crediting an account associated with said certain recipient comprises the substeps of defining the time it has taken for said indication to be received and crediting said *account* by an amount which is inversely proportional to said time. Goldhaber discloses the use of time-sensitive incentives such as coupons, in addition to credits to an account. It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Goldhaber to disclose time-sensitive credits, perhaps based on a subscriber's response time. One of ordinary skill in the art at the time the invention was made would have been motivated to extend Goldhaber to disclose time-sensitive credits, perhaps based on a subscriber's response time for the obvious reason that the value of

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information is often greater when the information is first posted. Goldhaber provides an example, Fig. 14, of information concerning a 1994 Explorer. Such information would likely be of less value as more time passes, perhaps in 2005.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JA
James Zurita
Patent Examiner
Art Unit 3625
28 February 2005


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